

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Moses CHAO

Application No.: 09/982,095

Conf. No. 6779

Filed: October 19, 2001

For: METHOD FOR SCREENING MOLECULES THAT EXERT A...

Art Unit: 1647

Examiner: R. C. Hayes

Washington, D.C.

Atty.'s Docket: CHAO=10A

Date: April 28, 2005



Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop Petition
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is a ☒ **PETITION UNDER 37 CFR 1.144 REQUESTING WITHDRAWAL OF RESTRICTION REQUIREMENT** [] _____
in the above-identified application.

☒ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

☒ No additional fee is required.

[] The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	* 11	MINUS	** 20	0
INDEP.	* 1	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

ADDITIONAL FEE TOTAL

SMALL ENTITY		
RATE	ADDITIONAL FEE	
x 25	\$	
x 100	\$	
+ 180	\$	
ADDITIONAL FEE TOTAL		\$

OR

OTHER THAN SMALL ENTITY		
RATE	ADDITIONAL FEE	
x 50	\$	
x 200	\$	
+ 360	\$	
TOTAL		\$

OR

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
 ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
 *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 60.00
 [] Second - \$ 225.00
 [] Third - \$ 510.00
 [] Fourth - \$ 795.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- [] First - \$ 120.00
 [] Second - \$ 450.00
 [] Third - \$ 1020.00
 [] Fourth - \$ 1590.00

Month After Time Period Set

[] Less fees (\$) already paid for ___ month(s) extension of time on _____.

[] Please charge my Deposit Account No. 02-4035 in the amount of \$_____.

[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$_____.

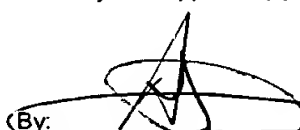
[] A check in the amount of \$_____ is attached (check no.).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

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By: 
 Allen C. Yun
 Registration No. 37,971



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: CHAO=10A

In re Application of:)	Art Unit: 1647
)	
Moses CHAO)	Examiner: R. C. Hayes
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Appln. No.: 09/982,095)	Washington, D.C.
)	
Date Filed: October 19, 2001)	Confirmation No. 6779
)	
For: METHOD FOR SCREENING)	April 28, 2005
MOLECULES THAT EXERT A...)	

**PETITION UNDER 37 CFR 1.144 REQUESTING WITHDRAWAL OF
RESTRICTION REQUIREMENT**

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop **Petition**
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants hereby petition for review by the Technology Center Director and for withdrawal of the requirement for restriction of June 20, 2004, and made final in the Office Action of November 2, 2004. This is a no fee petition and so no fee is necessary; however, if any fee is deemed necessary for consideration of this petition, please charge same to deposit account no. 02-4035 of the undersigned.

STATEMENT OF THE FACTS

The present application was filed with 12 claims, only one of which was independent. In a written restriction

requirement dated June 30, 2004, the examiner required restriction to one of the following:

Group I, including claims 1-8, drawn to a method for screening and identifying small molecules that transactivate a neurotrophin receptor and mediate neuronal survival comprising using assay A (treating neuronal cells with a small molecule and using an anti-phosphotyrosine antibody specific for a phosphorylated form of the receptor).

Group II, including claims 1-4, 6-8 and 11-12, drawn to a method for screening and identifying small molecules that transactivate a neurotrophin receptor and mediate neuronal cell survival comprising using assay B1 (treating neuronal cells with a small molecule and reacting P13-K with an anti-phospho-P13-K antibody and detecting binding).

Group III, including claims 1-4 and 6-10, drawn to a method for screening and identifying small molecules that transactivate a neurotrophin receptor and mediate neuronal cell survival comprising using assay B2 (treating neuronal cells with a small molecule and reacting Akt with an anti-phospho-Akt-antibody and detecting binding).

Group IV, including claims 1-4 and 6-8, drawn to a method for screening and identifying small molecules that transactivate a neurotrophin receptor and mediate neuronal cell survival comprising using assay C (treating cultured neuronal cells with a small molecule and determining cell survival).

In response to this requirement for restriction, an amendment was filed on July 29, 2004, amending independent claim 1 and electing Group I with traverse. The traversal in the

request for reconsideration was based on amendment of claim 1 to recite that the claimed method requires assay A but may also be performed in combination with either or both assay B (assays B1 and B2) and assay C.

In the next Office Action of November 2, 2004, the examiner did not find the traversal persuasive, stating that the methods of Groups II-IV remain distinct for the reasons of record in which claims 9-12 are held to be alternatively directed to limitations for only assays B1, B2 and/or C. The examiner further stated that a serious burden exists because of the different goals and method steps required for the search and examination of the claims of Groups II-IV, which are not required for examination of the method of Group I.

POINTS TO BE REVIEWED AND ACTION REQUESTED

It is respectfully requested that the restriction requirement be reviewed and that the examiner be compelled to withdraw the restriction requirement so that all Groups I-IV are examined together.

ARGUMENT

Applicants have amended independent claim 1 to recite "comprising assay A or assay A in combination with either or both of assay B and assay C". Thus, it is clear that assay A is required and always performed in the presently claimed method

while assays B and C are optional. Applicants have stated in traversing the restriction requirement that assays B and C are optional. It is preferred by applicants that assays B and C not be used not by themselves but in combination with assay A to confirm the results of assay A, i.e., they are merely confirmatory assays for the critical assay A required in the presently claimed method.

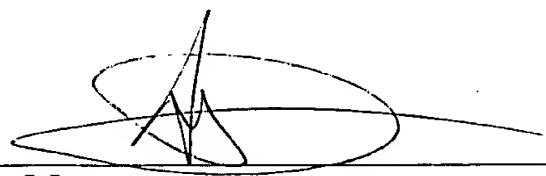
The present claims can be alternatively drafted to recite comprising assay A in independent claim 1 with the optional assays B and C recited only in dependent claims. In this alternative situation, the further assays B and C, or in other words, further steps are added to the generic method and should be examined together with the independent claim.

Accordingly, compelling the examiner to withdraw the restriction requirement is hereby earnestly solicited.

Respectfully submitted,

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